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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/817,543	04/02/2004	John J. McKillip	82536	2532

22242 7590 07/28/2006

FITCH EVEN TABIN AND FLANNERY
120 SOUTH LA SALLE STREET
SUITE 1600
CHICAGO, IL 60603-3406

EXAMINER

AHMAD, NASSER

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 07/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/817,543	MCKILLIP, JOHN J.	
	Examiner	Art Unit	
	Nasser Ahmad	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21 and 25 is/are allowed.
- 6) ☒ Claim(s) 1,3-15,17-20 and 22-24 is/are rejected.
- 7) ☒ Claim(s) 2 and 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Rejections Withdrawn

1. Claims 2-3, 15-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Casagrande (6322655) made in the last Office Action of 2/21/2006 has been withdrawn in view of the amendment filed on 5/19/2006.

Rejections Maintained

2. Claims 1, 3, 5-6, 11,13, 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Casagrande (6322655) for reasons of record made in the last Office Action of 2/21/2006.

3. Claims 4, 7- 10 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Casagrande in view of Fischer (5736212) for reasons of record made in the last Office Action of 2/21/2006.

4. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Casagrande for reasons of record made in the last Office Action of 2/21/2006.

Response to Arguments

5. Applicant's arguments filed 5/19/2006 have been fully considered but they are not persuasive.

Applicant argues tha Casagrande does not disclose an integrated tab being surrounded by the integrated removable portion. This is not deemed to be convincing because

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Casagrande, in figure-1, shows that the integrated removable portion is surrounded by the die-cut and hence, the tab portion, which is an integrated part of the removable portion, is surrounded by the die-cut. As for the second die-cut, see Casagrande #146 in figure-8.

As for claims 3 and 15, the base layer of Casagrande is adhesively (130) adhered to the liner layer (37), with release layer (134) thereon, and would have greater affinity for the adhesive because it is permanently adhered to the base layer.

Regarding applicant's argument about the 35 USC 103(a) rejection, the above explanation apply *a fortiori* herein.

Thus, in the absence of any evidence to the contrary, it remains the examiner's position that the claimed invention is anticipated or rendered obvious over the prior art of record discussed above.

6. The following are new grounds of rejection in view of the newly submitted claims.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claim 23 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which

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was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The phrase "does not extend completely" in newly presented claim 23 is found to be new matter for lack of support provided there by the applicant, as said phrase is a negative limitation which must have express support in the specification. as originally filed. In the absence of said support, said negative phrase changes the scope of the claimed invention.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 22-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Casagrande (6322655).

Casagrande relates to a business form (21) having a removable integrated card or label (47), and a method of making the same. The business form structure comprises a base layer (33), a liner layer (37) with adhesive (35) on its upper surface securing the liner to the base layer and a backing layer (43) adhesively (41) adhered to the liner layer. The

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liner is a transparent film (col. 9, line 9). As shown in figure-2, the structure is cut peripherally to form a card laminate with the die-cut (45) extending through the base layer and the liner layer. The cut shape is rectangular (col. 11, lines 1-4). The die-cut can be perforations (col. 9, lines 36-37) which would include the presence of bridges. Further, figure-8 shows the presence of an integrated tab (150) comprising a portion of the base layer and being coextensive with the integrated portion. The tab is defined by a periphery of a second die-cut (146) that extend substantially through the base layer, so that the liner at least partially maintains the tab against unintentional removal from the form. Casagrande also teaches a method of making comprising providing a base layer, adhesively securing a liner layer to the base layer, forming a card by plurality of spaced die-cuts or perforations through the base and the liner layers, and making a second die-cut to form the integrated removable tab coextensive with the integrated portion.

The base would have a greater affinity for retaining the adhesive (130) than the liner layer because of the presence of the release layer (134) in-between.

The intended use phrases such as "removable", "for retaining", "when the tab is at least partially removed", etc. have not been given any patentable weight because said phrases are not found to be of positive limitation.

Allowable Subject Matter

11. Claims 21, 25 are allowed.

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12. Claims 2, 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art fails to teach that the backing layer has lesser affinity for retaining adhesive than the liner layer.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

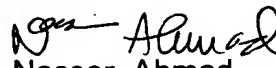
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-

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1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 7/23/06
Nasser Ahmad
Primary Examiner
Art Unit 1772

N. Ahmad.
July 23, 2006.